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MICROSOFT CORPORATION

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

OAKLAND DIVISION

INTERTRUST TECHNOLOGIES CORPORATION, a Delaware corporation,
 	
        Plaintiff,
 	
        v.
 	
MICROSOFT CORPORATION, a Washington corporation,
 	
        Defendant.
	CASE NO. C01-1640 SBA
	
	MICROSOFT CORPORATION'S PATENT LOCAL RULE 4-2 DISCLOSURE OF PRELIMINARY CLAIM CONSTRUCTION AND EXTRINSIC EVIDENCE (LIMITED TO "MINI-MARKMAN" CLAIMS)

MICROSOFT CORPORATION, a Washington corporation,
 	
        Counterclaimant,
 	
        v.
 	
INTERTRUST TECHNOLOGIES CORPORATION, a Delaware corporation,
 	
        Counter Claim-Defendant.	

1   Pursuant to Patent Local Rule 4-2 and this Court's Order, entered November 5, 2002,

2   Defendant Microsoft Corporation ("Microsoft") hereby serves its "Disclosure Of Preliminary

3   Claim Construction And Extrinsic Evidence," limited to the twelve selected "Mini-Markman"

4   patent claims. Microsoft's preliminary claim construction is based upon the proposed terms,

5   phrases and clauses, and claims as a whole, identified by the parties in their submissions in

6   accordance with Patent Local Rule 4-1(a) and conference in accordance with Patent Local Rule 4-

7   1(b).

8   Microsoft provides its preliminary claim construction of each of the 12 "Mini-Markman"

9   claims subject to the limitations and reservations of rights set forth herein. Microsoft does not

10   waive any defenses that the asserted claims fail to satisfy the provisions of 35 U.S.C. § 112

11   including, for example, the written description requirement, the definiteness requirement, or any

12   other requirement for patentability. Microsoft does not concede that the asserted claims are

13   supported by Plaintiff's original application or any application from which they purportedly claim

14   priority. Specifically, by offering a construction of a term, Microsoft does not waive any defense

15   that the claim is in fact indefinite and there can be no proper construction.

16   Microsoft provides its preliminary claim construction in the following format. Exhibit A

17   sets forth Microsoft's preliminary construction of (1) the claim term "virtual distribution

18   environment" ("VDE"), (2) the "VDE invention" disclosed in the February, 1995, InterTrust

19   patent application, and (3) certain other claim terms. Exhibit B sets forth Microsoft's preliminary

20   construction of the disputed claims as a whole, and particular claim phrases in dispute, in the

21   order of appearance in a claim. Where an individual claim term (within a phrase) is also in

22   dispute, it will be bold-faced in Exhibits A and B. Exhibit C sets forth Microsoft's preliminary

23   construction of the individual terms in dispute, in alphabetical order.

24   Microsoft reserves the right to modify its preliminary claim constructions in the event that

25   the parties are unable to agree upon a particular claim construction. Furthermore, because

26   InterTrust has not yet fully complied with the disclosure requirements of Patent Local Rules 3-1

27   and 3-2, Microsoft expressly reserves the right to amend its preliminary claim construction if

28

1 evidence becomes available through those disclosures (or that should have been provided therein)

2 that would support amended constructions. Microsoft further reserves the right to amend its

3 preliminary claim constructions once it has an opportunity to review InterTrust's preliminary

4 claim constructions and once the parties have further met and conferred as required.

5

6   Preliminary Identification of Evidence in Support of Claim Construction

7   Microsoft's preliminary claim construction is supported by the intrinsic record of the

8 seven U.S. patents from which the 12 "Mini-Markman" claims are selected. For the purposes of

9 submission of this preliminary claim construction only, Microsoft treats the "intrinsic" evidence

10 as including: 1) the specifications of each of the seven U.S. patents at issue in the "Mini-

11 Markman" proceeding, including any material purportedly incorporated by reference therein;

12 2) the prosecution history of each of the seven patents at issue, including the applications and

13 prosecution history of the seven patents and any related patent applications, including without

14 limitation, applications purportedly incorporated by reference or to which an application claimed

15 priority; and 3) all references cited in the prosecution of any such applications. In accordance

16 with the local rules, this evidence is not specifically identified, except to the extent that Microsoft

17 asserts particular sections of a patents' specifications provide "structure" for claims properly

18 construed under 35 U.S.C. § 112(6).

19   In certain circumstances, Microsoft's preliminary construction may be supported by

20 extrinsic evidence presently available to Microsoft. Microsoft reserves the right to modify or

21 supplement with evidence that it has not yet been able to fully review, due to InterTrust's

22 production, including without limitation, InterTrust re-production of over 1,000,000 pages on

23 November 4, 2002. Microsoft reserves the right to supplement with additional evidence gathered

24 in the course of the discovery collected between now and the close of "claim construction"

25 discovery or later submitted by InterTrust in full compliance with its disclosure obligations under

26 Patent Local Rules 3-1 and 3-2. Extrinsic evidence is identified or produced in accordance with

27 the local rule and set forth in the following exhibits:

28

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Exhibit D: Contains copies of excerpts from dictionaries and other publications. Due to the volume of the appended pages, Exhibit D will be served via Federal Express.

Exhibit E: Contains a list of selected production documents, identified by initial bates number.

Exhibit F: Contains a list of selected, uncited prior art publications, identified by bates number(s).

Exhbit G: Contains a list of selected, uncited prior art patents, identified by bates number(s).

In addition to the extrinsic evidence cited in Exhibits D-G, Microsoft incorporates by reference herein and reserves the right to rely upon: 1) all documents identified by InterTrust in response to discovery or pursuant to the Patent Local Rules; 2) all InterTrust patents, publications and other things that are prior art to any Mini-Markman claim; and 3) the testimony of InterTrust and the witnesses identified below.

Preliminary Identification of Witnesses[1]

Professor John Mitchell: Dr. Mitchell will testify of the following matters:

1) that certain of the presently disputed terms and phrases used in the twelve claims are amorphous terms lacking a well-defined, precise meaning that can accurately be gleaned from technical or other dictionaries. Rather, these terms are used in the art and/or in the patents in a manner that requires close consideration of the entire patent specification to put them in proper context and determine their precise, correct meaning as used in the patents. These terms include "secure container," "control," "govern," "protect," "protected processing environment," "secure," "securely," "security," "virtual distribution environment";

2) that the concepts stated in the InterTrust patents were known to the art, including the cited prior art, which cited art he will describe;

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[1] In accordance with the local rules, Microsoft identifies witness testimony that it contends will support its construction. It has not identified herein testimony relevant to the "tutorial" to be held prior to the claim construction hearing.

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1   3) the level of skill, background, and understanding (including extent thereof) of the

2 relevant patent application disclosures by a person of skill in the art; and

3   4) the meaning and scope certain disputed claim language, including "secure container,"

4 "control," "govern," "protect," "protected processing environment," "secure," "securely,"

5 "security," and "virtual distribution environment."

6   **Professor David Maier:** Dr. Maier will testify on the following matters:

7   1) what the February 13, 1995, patent application (SN 08/388,107) and the seven

8 InterTrust patents, described as the "invention;" more particularly, what are the required,

9 necessary, non-optional features of the "VDE" "invention" as stated in the patents. This

10 description will include an explanation of the features set forth in Microsoft's "Global

11 Constructions" (Exhibit A).

12   2) what the February 13, 1995, patent application (SN 08/388,107) and the seven

13 InterTrust patents, required as necessary, non-optional building blocks to implement the "VDE"

14 "invention" as stated in the patents.

15

16 Dated: December 20, 2002

17

18 By: _____

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DECLARATION OF SERVICE BY E-MAIL

I am more than eighteen years old and not a party to this action. My place of employment and business address is 121 S.W. Salmon St., Suite 1600, Portland, OR 97204.

On December 20, 2002, at 3:00 p.m., I served on counsel for InterTrust Technologies Corporation:
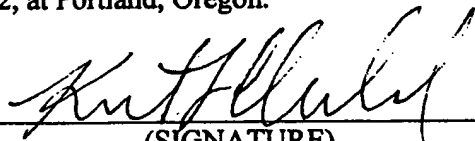
MICROSOFT CORPORATION'S PATENT LOCAL RULE 4-2
DISCLOSURE OF PRELIMINARY CLAIM CONSTRUCTION AND
EXTRINSIC EVIDENCE (LIMITED TO "MINI-MARKMAN" CLAIMS)

by email delivery to:

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I declare under penalty of perjury that the foregoing is true and correct.

Executed on December 20, 2002, at Portland, Oregon.

_____
(SIGNATURE)

_____
Kristin L. Cleveland
(PRINT NAME)

MICROSOFT CORPORATION'S PATENT LOCAL
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MARKMAN" CLAIMS), CASE No. C 01-1640 SBA